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EXAMINER	
ROWLAND, STEVE	
ART UNIT	PAPER NUMBER
3714	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/547,684	MITCHELL ET AL.	
	Examiner	Art Unit	
	Steve Rowland	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 August 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-50* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-50* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *30 August 2005* is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *08/30/2005*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the claimed method steps including, *inter alia*, "generating a partial outcome for a first sub-game of the game," "determining an expected value of an outcome of the first sub-game arising from said partial outcome," and "determining partial outcomes for remaining sub-games of the game" must be depicted or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claim 50 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims must begin with a capital letter and end with a period; claim 50 contains additional limitations after the phrase "will win." It is thus unclear whether Applicant intends to claim these additional limitations. For the purposes of examination, it is assumed that these limitations are unintentional surplusage. Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-6, 8-10, 36-41, and 43-45 are rejected under 35 U.S.C. 102(b) as being anticipated by Williams (US Pat. No. 6,132,311)

Regarding claim 1, Williams teaches a machine comprising a display (col. 5, lines 1-8), a game controller arranged to control images of symbols displayed on the display (col. 4, lines 59-67), the game controller being arranged to play a game wherein at least one random event is caused to be displayed on the display and, if a predefined winning event occurs, a prize is awarded (Abstract), and a plurality of sub-games constituting the game displayed on the display with, as an initial display, fewer than a full set of images of each of the sub-games being displayed to show a partial outcome of the game (Fig. 1), the fewer than the full set of images being representative of a determination of an expected value for each of the sub-games (Fig. 3).

Regarding claims 2 and 37, Williams teaches each sub-game has a plurality of image carrying elements, each of which carries a plurality of images required to be considered in assessing an outcome of the game (col. 7, lines 29-67; col. 8, lines 1-7).

Regarding claims 3 and 38, Williams teaches an initial display of each sub-game where fewer than all of the image carrying elements of the sub-games are displayed to display the partial outcomes of the sub-games (Fig. 2).

Regarding claims 4 and 39, Williams teaches an expected value of the first sub-game as derived from the displayed partial outcome of the first sub- game which is used to select the displayed fewer than all of the image carrying elements of the remaining sub-games in the initial display (Fig. 3).

Regarding claims 5 and 40, Williams teaches a game controller which includes a data storage element in which data relating to expected values for each of the remaining sub-games are stored (20).

Regarding claims 6 and 41, Williams teaches data which are stored in the form of look-up tables for each of the sub-games (20).

Regarding claims 8 and 43, Williams teaches a sub-game which has a feature game associated with it and, if that feature is won, the feature is also played before the game is concluded (col. 8, lines 14-29).

Regarding claims 9 and 44, Williams teaches a feature associated with each sub-game which is a no-cost feature (col. 8, lines 14-29).

Regarding claims 10 and 45, Williams teaches a feature associated with each sub-game which is triggered by the controller independently of the result of a base sub-game preceding the triggered feature (col. 8, lines 14-29).

Regarding claim 36, Williams teaches a game to be played on a gaming apparatus having a display (col. 5, lines 1-8) and being controlled by a game controller arranged to control images displayed on the display (col. 4, lines 59-67), the game comprising a plurality of sub- games constituting the game displayed on the display with, as an initial display, fewer than a full set of images of each of the sub-games being displayed to show a partial outcome of the game

(Abstract), the fewer than the full set of images being representative of a determination of an expected value for each of the sub-games(Fig. 3).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 16-29 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams.

Regarding claims 7 and 42, it is noted that Williams does not specifically teach a controller which accesses lookup tables for each of the remaining sub-games to ascertain the

expected value for each of the remaining sub-games which most closely approximates the expected value for the first sub-game. However, it is the Examiner's opinion gaming that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Williams to track and control the expected value of game outcomes in order to balance payouts with coin-in and thus manage profit margins.

Regarding claim 16, Williams teaches a gaming machine comprising a display (col. 5, lines 1-8), a game controller arranged to control images of symbols displayed on the display (col. 4, lines 59-67), the game controller being arranged to play a game wherein at least one random event is caused to be displayed on the display and, if a predefined winning event occurs, a prize is awarded (Abstract), and the game controller using a table of expected values to display less than all of the images of the game. It is noted that Williams does not specifically disclose images which are spinning reels. However, it is the Examiner's position that it would have been obvious to a person of ordinary skill in the art at the time the invention was made that video selection games can use images which comprise any number of types of symbols, including playing cards, pictures, or simulated spinning slot machine reels.

Regarding claim 17, Williams teaches a game which comprises a plurality of sub-games (Fig. 1), and a game controller which uses the table of expected values to display less than all of the images of each sub-game (Fig. 3). It is noted that Williams does not specifically disclose images which are spinning reels. However, it is the Examiner's position that it would have been obvious to a person of ordinary skill in the art at the time the invention was made that video selection games can use images which comprise any number of types of symbols, including playing cards, pictures, or simulated spinning slot machine reels.

Regarding claim 18, Williams teaches a method of playing a wagering game including generating a partial outcome for a first sub-game of the game and determining an expected value of an outcome of the first sub-game arising from said partial outcome and displaying the

partial outcomes of the sub-games of the game on a display of a gaming apparatus (Abstract). It is noted that Williams does not specifically teach determining partial outcomes for remaining sub-games of the game, the partial outcomes for each of the remaining sub-games being representative of an expected value for each of the remaining sub-games, the expected value for each of the remaining sub-games being approximately the same as the expected value for the first sub-game. However, it is the Examiner's opinion gaming that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Williams to track and control the expected value of game outcomes in order to balance machine payouts with coin-in and thus manage profit margins.

Regarding claim 19, Williams teaches a sub-game which has a plurality of image carrying elements, each of which carries a plurality of images required to be considered in assessing an outcome of the game (Fig. 3) and in which the method includes, in an initial display of each sub-game, displaying fewer than all of the image carrying elements of the sub-games to display a partial outcome of each of the sub-games (Fig. 2).

Regarding claim 20, Williams teaches determining a display configuration for the fewer than all of the image carrying elements of the first sub- game to provide the partial outcome for the first sub-game (Fig. 2).

Regarding claim 21, Williams teaches, once the display configuration of the partial outcome of the first sub-game has been determined, determining the expected value of the first sub-game (Abstract).

Regarding claim 22, Williams teaches using the expected value of the first sub-game to select the displayed fewer than all of the image carrying elements constituting the partial outcomes of the remaining sub-games (Abstract).

Regarding claim 23, Williams teaches storing data relating to expected values for each of the remaining sub-games in a game controller of the game playing apparatus (20).

Regarding claim 24, Williams teaches storing the data in the form of look-up tables for each of the sub-games (20).

Regarding claim 25, it is noted that Williams does not specifically teach, once the expected value for the first sub-game has been determined, accessing the look-up tables for each of the remaining sub-games to ascertain the expected value for each of the remaining sub-games which most closely approximates the expected value for the first sub-game. However, it is the Examiner's opinion gaming that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Williams to track and control the expected value of game outcomes in order to balance payouts with coin-in and thus manage profit margins.

Regarding claim 26, Williams teaches, once the expected values of the remaining sub-games have been selected, determining the displayed fewer than all of the image carrying elements of the remaining sub-games and displaying the fewer than all of the image carrying elements of the remaining sub- games (Abstract).

Regarding claim 27, Williams teaches not displaying any information relating to the remaining, non- displayed image carrying elements of each of the sub-games (Fig. 1).

Regarding claim 28, Williams teaches requiring a player to place a wager prior to displaying the partial outcomes of the sub-games (col. 6, lines 35-45).

Regarding claim 29, Williams teaches initially placing the wager on all of the sub-games of the game (Abstract).

8. Claims 11-14, 30-34, and 46-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams in view of Cannon et al (US Pub. No. 2002/0183105 A1) (hereinafter "Cannon").

Regarding claims 11 and 46, it is noted that Williams does not teach features associated with the sub-games which differ from one another. However, Cannon teaches features

associated with the sub-games which differ from one another (¶ [0115]). Hence, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Williams and Cannon in order to create diverse and captivating bonus presentations which will potentially induce longer play.

Regarding claims 12 and 47, it is noted that Williams does not teach a game which has a jackpot bonus feature associated with it. However, Cannon teaches a game which has a jackpot bonus feature associated with it (¶ [0036]). Hence, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Williams and Cannon in order to create an exciting game in which the player competes for a larger than normal payout, thus potentially inducing longer play.

Regarding claims 13 and 48, it is noted that Williams does not teach a progressive jackpot bonus feature. However, Cannon teaches a progressive jackpot bonus feature (¶ [0078]). Hence, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Williams and Cannon in order to create a captivating game in which the player competes for an ever-increasing payout, thus potentially inducing longer play.

Regarding claims 14 and 49, it is noted that Williams does not teach a progressive jackpot which comprises at least two jackpot levels being a minor jackpot and a major jackpot. However, Cannon teaches a progressive jackpot which comprises at least two jackpot levels being a minor jackpot and a major jackpot (¶ [0120]). Hence, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Williams and Cannon in order to create a captivating game in which the player competes for an ever-increasing and variable payout, thus potentially inducing longer play.

Regarding claim 30, it is noted that Williams does not teach offering the player the option of transferring the wager to one or fewer than all of the sub-games when the partial

outcomes of the sub-games have been displayed. However, Cannon teaches offering the player the option of transferring the wager to one or fewer than all of the sub-games when the partial outcomes of the sub-games have been displayed (¶ [0103] lines 11-21). Hence, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Williams and Cannon in order to make the gaming machine easier and more user-friendly to play.

Regarding claim 31, it is noted that Williams does not teach each sub-game having a feature game associated with it and in which the method includes, if that feature is won, playing off the feature before concluding the game. However, Cannon teaches teaches each sub-game having a feature game associated with it and in which the method includes, if that feature is won, playing off the feature before concluding the game (¶ [0128]). Hence, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Williams and Cannon in order to create diverse and captivating bonus presentations which will potentially induce longer play.

Regarding claim 32, Williams teaches awarding the feature as a no-cost feature (col. 8, lines 14-29).

Regarding claim 33, Williams teaches triggering the feature associated with each sub-game independently of the result of a base sub-game preceding the triggered feature (col. 8, lines 14-29).

Regarding claim 34, it is noted that Williams does not teach differentiating the features associated with the sub-games from one another. However, Cannon teaches differentiating the features associated with the sub-games from one another (¶ [0115]). Hence, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Williams and Cannon in order to create diverse and captivating bonus presentations which will potentially induce longer play.

9. Claims 15, 35, and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams in view of Cannon and Baerlocher (US Pub. No. 2003/0054877 A1).

Regarding claims 15 and 50 as best understood, it is noted that neither Williams nor Cannon teaches a gaming machine in which, when the bonus feature is triggered, an animation is displayed which indicates to the player which level of jackpot the player will win. However, Baerlocher teaches a gaming machine in which, when the bonus feature is triggered, an animation is displayed which indicates to the player which level of jackpot the player will win (¶ [0011]). Hence, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Williams, Cannon, and Baerlocher in order to create an interesting and exciting visual display.

Regarding claim 35, it is noted that Williams does not teach a game which has a bonus jackpot feature associated with it, the bonus jackpot feature being a progressive jackpot feature having at least two jackpot levels and in which the method includes displaying an animation which indicates to the player which level of jackpot the player will win. However, Cannon teaches a game which has a bonus jackpot feature associated with it, the bonus jackpot feature being a progressive jackpot feature having at least two jackpot levels and in which the method includes (¶ [0036]; ¶ [0078]). Baerlocher teaches displaying an animation which indicates to the player which level of jackpot the player will win (¶ [0011]). Hence, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Williams, Cannon, and Baerlocher in order to create a visually-interesting and captivating game in which the player competes for an ever-increasing payout, thus potentially inducing longer play.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Angel (US Pat. No. 6,695,695 B2) discloses a video poker machine that plays multiple simultaneous hands.

Yoseloff (US Pat. No. 6,312,334 B1) discloses a multi-stage video wagering game.

Yoseloff (US Pat. No. 6,331,143 B1) discloses a video numbers game using a subset of symbols.

Breeding (US Pat. No. 6,334,614 B1) discloses a multi-tiered wagering game.

Barrie (US Pat. No. 5,980,384) discloses a gaming machine with a integrated first and second game.

De Keller (US Pat. No. 6,379,245 B2) discloses a video gaming machine with partial outcome wagering.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steve Rowland whose telephone number is (571) 270-7844. The examiner can normally be reached on Monday through Thursday, alternate Fridays, 8:30 am to 6:00 pm, Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dmitry Suhol can be reached on (571) 272-4430. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/S. R./
Examiner, Art Unit 3714

/John M Hotaling II/
Supervisory Patent Examiner, Art Unit 3714